

Remarks/Arguments

These remarks/arguments are responsive to the February 23, 2005 Office Action.

As an initial matter, applicant requests that the Examiner correct the spelling of applicant's name in the correspondence address. Twice now the correspondence has been addressed to "Ricahrd" Lehrer instead if Richard Lehrer.

More substantively, applicant respectfully points out that the Examiner failed to provide a bona fide response to applicant's November 29, 2004 response to the improper October 28, 2004 restriction requirement. The Examiner has also improperly misrepresented applicant's statements made in the November 29, 2004 response. In response to the restriction requirement, applicant requested the examiner to reconsider and withdraw the restriction requirement, or at the very least to state his reasons for the restriction and to identify the claims and claim elements in accordance with the requirements of the M.P.E.P. Applicant also provisionally elected Group 1 and all claims readable thereon. In the present office action, the Examiner makes no mention of either of these facts but instead misrepresents that applicant asserted that every claim reads on Group 1. Applicant never made such an assertion.

Improper Restriction Requirement

In the October 28, 2004 Office Action, the Examiner required applicant to elect a single disclosed species for prosecution under 35 U.S.C. § 121.

According to the Examiner the application contains claims (unspecified by the Examiner) directed to the following patentably distinct species (unspecified why patentably distinct) of the claimed invention:

Group 1: figures 1-4;

Group 2: figure 5;

Group 3: figure 6;

Group 4: figure 7;

Group 5: figure 8;

Group 6: figure 9;

Group 7: figure 10;

Group 8: figure 11;

Group 9: figure 12;

Group 10: figure 13;

Group 11: figure 14; and,

Group 12: figure 15.

However, the Examiner failed to (1) identify the claims which were allegedly patentably distinct and (2) state any reasons for the Examiner's assertion, both of which are required by the MPEP and both of which were pointed out by the applicant in the response filed November 29, 2004.

As stated in applicant's November 29, 2004 response, it is the Examiner's burden to identify which claims are directed to different species and in particular to identify which elements of the claims are considered to restrict the claims to a particular disclosed species to make the requirement clear. (*see* M.P.E.P. §§814-817). According to M.P.E.P. §816, "the particular reasons relied on by the examiner for holding that the inventions as claimed are either independent or distinct should be concisely stated." In the October 28, 2004 office action, the Examiner failed to state which claims are believed to be directed to different species. Instead the Examiner only provided conclusory

statements that the application contains claims directed to patentable distinct species identified by the various figures. The examiner has failed to even provide an indication as to why the figures illustrate patentably distinct species. The examiner then attempts to improperly shift the burden of identifying the claims to applicant by stating “applicant is advised that a reply to this requirement must include an identification of the species that is elected . . . and a listing of all claims readable thereon. . .” This attempt to shift the burden is improper and applicant respectfully holds the Examiner to his burdens of identifying the claims and why the Examiner believes they are directed to patentably distinct species.

Clearly the restriction requirement was inadequate and applicant respectfully requests Examiner to reconsider and withdraw the restriction requirement.

In addition to the restriction requirement, the Examiner incorrectly stated that currently no claim is generic. Simply to illustrate that the Examiner’s statement was incorrect, applicant pointed out that Claim 1 was generic to all of the figures. This was by no means an exhaustive list. In fact, a review of the claims reveals that at the very least the independent claims (Claims 1, 12 and 17) are each generic to all of the figures. Additionally, a closer review reveals that dependent claims 10 and 11 are also generic to all of the figures.

Once again, applicant respectfully requests the Examiner to abide by the rules of the M.P.E.P. and reconsider and withdraw his incomplete and improper restriction requirement or at the very least to provide the claims he asserts are patentably distinct and the reasons for such assertions.

In an effort to ensure that the Examiner does not attempt to assert that applicant has failed to provide a bona fide response, applicant **provisionally** cancels claims 5-7, 9, and 14-16 but specifically maintains the right to reinstate each of the canceled claims should any of the generic claims be allowed.

#### Drawings

In the February 23, 2005 Office Action, the Examiner objected to the drawings for not showing the slit on the top or bottom with the connector configured to extend through the slit. Applicant has provided new figures 16 and 17 illustrating the requested features respectfully. No new matter has been added as these drawings are supported by claims 5 and 6 as indicated by the Examiner and by the specification at pg. 9, lns. 10-16.

Accordingly, applicant respectfully submits that the objections to the drawings have been overcome and the Examiner should withdraw the same.

#### 35 U.S.C. §112(2)

In the February 23, 2005 Office Action, the Examiner rejected claims 5-7, 9, 15 and 16 as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. However, then the Examiner only discusses claims 5-7, 9 and 11. According to the Examiner, regarding Claim 5 it is unclear where the slit on the top is in the elected embodiment; regarding Claim 6 it is unclear where the slit on the bottom is in the elected embodiment; regarding Claim 7 it is unclear where the hole is on the elected embodiment; regarding Claim 9 it is unclear where the plurality of ribs being connected at a point below the top portion are in the elected embodiment; regarding claim 11, it is unclear where the bases are connected

together. According to the Examiner applicant must point out where these features are in the elected embodiment or withdraw these claims from further consideration.

Applicant respectfully traverses these rejections for the aforementioned reasons. Additionally, with respect to Claim 11, it is apparent by simply looking at the figures in Group 1 that the bases are connected together, however for purposes of providing a consideration to the Examiner, applicant points out that the bases are connected together via the ribs 30 and the connector 50 (although this manner of connection is by no means a limitation on the claim). This is also disclosed in the specification at page 8, 15-23. With regard to Claims 5-7, 9, and 15-16 applicant has **provisionally** elected to cancel these claims, without prejudice to reinstate them should the Examiner maintain his improper restriction requirement and should a generic claim be allowed. Accordingly, whether the Examiner maintains his improper restriction requirement or not applicant has overcome these rejections.

35 U.S.C. §102(b)

In the February 23, 2005 Office Action, the Examiner rejected claims 1, 3-6, 8-11 and 17 as being anticipated by U.S. Patent No. 1,049,910 to Peck ("Peck"). According to the Examiner, Peck teaches a box having a plurality of ribs secured to a plurality of bases that are adhered to the bottom of the box, wherein the ribs are selectively moveable between a storage position and a support position as shown in 1 and 2. Applicant respectfully traverses this rejection.

Claim 1 of the present application recites a box for transporting hot food. . .while maintaining a portion off of the bottom of the box, the box having "a plurality of ribs, secured to a plurality of bases, at least 1 of said plurality of bases is adhered to the bottom

of the box, the plurality of ribs are selectively moveable between a storage position and a support position, the storage position being substantially flat relative to said bottom and said support position being substantially perpendicular relative to said bottom; a connector coupled to said plurality of ribs and configured to extend from the inside of the box to the outside of the box, wherein the connector is configured to simultaneously move the plurality of ribs between the storage position and the support position; and to prevent the ribs from moving back to the storage position by mating with the box.”

Peck in contrast is a compartmentalized box, which enables the contents of the box to be separated into various compartments. Peck does not disclose a box for transporting hot food. . .while maintaining a portion off of the bottom of the box. According to Peck, “The holes 28 and their companion tongues 24 coincide with the spaces between the tongues20 when the latter are in the last described position. The eggs or other articles may now be placed in the cells. . .” (Col. 2, ,lns. 80-88 Peck). Accordingly, when the tongues 20 of Peck are erected, they are not erected into a “support position” as in the present claim, but rather they are erected into a separating position. This is significantly different since the ribs of the present invention need to be capable of maintaining a portion of food off of the bottom of the box. The tongues in Peck would not be capable of such support and do not teach or suggest such support. In fact, Peck teaches away from the present invention by providing companion tongues 24 (not the connector as in Claim 1), which appear to maintain the tongues 20 in the erect position and which further divide the box into additional compartments. These companion tongues extend from the top of the box to below the top of the erected tongues and would thus prevent food from being supported by the tongues 20. Further still, Peck

fails to disclose a connector coupled to the ribs, which is configured to prevent the ribs from moving back to the storage position by mating with the box. The string 21 in Peck does not mate with the box to prevent the tongues 20 from collapsing. Instead, as discussed above, it appears that the companion tongues 24, which have no connection with the erection of the tongues 20 are used to maintain the tongues 20 in the erected position. Thus for this reason as well, Peck does not anticipate Claim 1 of the present invention.

Claims 3-6, and 8-11 depend from Claim 1. Accordingly, these claims are novel over Peck for at least the reasons discussed above.

Claim 17 of the present application recites an apparatus for supporting hot food in a delivery box. The apparatus includes a blank of material, configured to be adhered to the bottom of the box, having a plurality of horizontal and vertical cuts therein. The horizontal cuts form a plurality of rib/base pairs and the vertical cuts form a pull tab coupled to the plurality of rib/base pairs only by the ribs. At least two of the horizontal cuts partially separate at least two of the ribs from at least two of the bases. The pull tab is configured to mate with the box after it is pulled and the pull tab is configured to simultaneously rotate at least two of the ribs from a substantially flat position to a substantially perpendicular position.

As stated above, Peck fails to disclose an apparatus for supporting hot food in a delivery box. In contrast, the box of Peck is designed to separate the contents into compartments. For this reason alone, Peck fails to anticipate Claim 17. In addition, Claim 17 recites that the vertical cuts form a pull tab and the pull tab is configured to mate with the box after it is pulled. In other words, the pull tab is integral with the ribs

and bases and mates with the box. The box in Peck requires a separate string pulled through holes in the tongues, which somehow is capable of erecting the tongues. The string is not integral with the tongues and it is not configured to mate with the box after it is pulled. Accordingly, for these reasons as well, Peck fails to anticipate Claim 17 of the present invention.

For the foregoing reasons, the Examiner is respectfully requested to reconsider and withdraw his rejection of Claims 1, 3-6, 8-11 and 17.

35 U.S.C. §103(a)

In the February 23, 2005 Office Action, the Examiner rejected Claims 12-16 as being unpatentable over Peck in view of either U.S. Patent No. 1,083,514 to Wright ("Wright") or 861,899 to Rhodes ("Rhodes"). According to the Examiner, it would have been obvious to one of ordinary skill in the art to lock the connector against an outside of the box either by tying the string as shown in Rhodes or providing anchor 12 as shown in Wright to keep the ribs from folding back.

Applicant respectfully traverses these rejections. First, there is no teaching or suggestion to one of ordinary skill in the art, faced with the problem of carrying a hot food in a closed box while maintaining at least a portion off the bottom of the box (as in the present invention), to modify Peck by either Wright or Rhodes to obtain same. However, such teaching or suggestion to combine the references is required as a matter of law:

To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that created the case of obviousness. In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor



and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998). See also, *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999) (“Combining prior art references without evidence of such a suggestion, teaching or motivation [to do so] simply takes the inventor’s disclosure as a blueprint for piecing together the prior art to defeat patentability — the essence of [impermissible] hindsight.”).

The Examiner in the present case has not proffered a motivation in the references or otherwise to combine Peck with Wright or Rhodes to arrive at the present invention. Indeed, the Examiner has not shown why Wright, which is directed to a reversible reusable box, which is bound by a tape or chord is even relevant to the present invention. The Examiner has also not shown why Rhodes, which is directed to a box which formed of a blank that may be folded up and fastened into the form of a box without the use of any separate cover is relevant to the present invention. Additionally, there would be no reason one skilled in the art would combine these references as suggested by the Examiner since, as stated above, it appears that Peck uses the companion tongues 24 to maintain the tongues 20 in the erected position and neither Wright nor Rhodes employs tongues or any other separators to compartmentalize the box.

In the February 23, 2005 Office Action, the Examiner rejected Claims 1, 3, 4, and 7-14 as being unpatentable over U.S. Patent No. 4,927,073 to Esposito (“Esposito”) in view of U.S. Patent No. 4,081,125 to Meyers (“Meyers”). According to the Examiner, Esposito “meets all claimed limitations except for the bases adhere (*Sic.*) to the bottom of the box.” The Examiner then asserts that “it would have been obvious. . . to provide the bases 25a adhere (*Sic.*) to the box in Esposito as taught by Meyers to provide a more rigid

partition.” According to the Examiner, “with respect to the method claims, it is submitted that the steps recited in the method claims do not read over the teachings in Esposito.” Applicant respectfully traverses these rejections.

As stated above with respect to Peck, Esposito discloses a compartmentalized box, which enables the contents of the box to be separated into various compartments. Accordingly, when the transverse pieces 36 of Esposito are erected, they are not erected into a “support position” as in the present claim. Instead, they are erected into a separating position. This is significantly different from the present invention since the ribs of the present invention need to be capable of maintaining a portion of food off of the bottom of the box. The transverse pieces 36 of Meyers do not teach or suggest such support. Especially since the transverse pieces 36 of Meyers are level with the top of the box (as seen from the figures). Additionally, the transverse pieces 36 of Meyers do not have bases. So in addition to not having bases adhered to the bottom Esposito simply does not have bases.

Meyers fails to cure the deficiencies of Esposito. The partition section 25b fails to disclose a support position for the partition. As indicated by its name, the partition is used to partition the tray of Meyers into different sections.

Additionally, there is no teaching or suggestion to combine Esposito and Meyers in the manner suggested by the Examiner. However, such teaching or suggestion to combine the references is required as a matter of law:

To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that created the case of obviousness. In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor

and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998). See also, *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999) (“Combining prior art references without evidence of such a suggestion, teaching or motivation [to do so] simply takes the inventor’s disclosure as a blueprint for piecing together the prior art to defeat patentability — the essence of [impermissible] hindsight.”).

The Examiner in the present case has not proffered a motivation in the references or otherwise to combine Esposito with Rhodes to arrive at the present invention. Indeed, the Examiner has not shown why Meyers, which is directed to a partitioned tray (not a box) is even relevant to the present invention.

In addition to the above, the references teach away from the suggested combination. According to Esposito, the tray is converted to a box by pulling the strap, which runs through all the transverse walls, towards the first short end to lift each divider to the perpendicular, simultaneously lifting the sides and ends to the perpendicular to form the side and end walls of a box with and open top. (*See*. Col. 2, lns. 49-54). Accordingly, the transverse walls are employed to lift the side walls of the box. In Meyers, the partition is configured in such a way that its erection has no affect on the side walls of the box. (*See*. Col. 2, lns. 28-36 and 63-68). Accordingly, one skilled in the art, without knowledge of the present patent application would not use the partition of Meyers in place of the transverse walls of Esposito.

Claims 3, 4 and 7-11 depend from Claim 1. As such, these claims are not rendered obvious for the same reasons. Claim 12 is novel for at least some of the same

reasons as stated above regarding Claim 1. Claims 13-14 depend from Claim 12. As such, Claims 13 and 14 are novel for at least the same reasons.

For the foregoing reasons, the Examiner is respectfully requested to reconsider and withdraw the rejections of Claims 1, 3, 4, and 7-14.

#### Objections

Claim 2 was objected to as being dependent upon a rejected base claim. As shown from the foregoing discussion of the claims and cited art, Claim 1 is novel over the cited art. As such, applicant respectfully requests the Examiner to reconsider and withdraw the objection to Claim 2.

#### Amendments to the Claims

The above notwithstanding, applicant has amended Claims 1 and 12 to more clearly define that the support position of the ribs is a position for supporting food off of the bottom of the box but below the top of the box. These amendments were in no way made to overcome the cited art. The claims were already novel over the cited art for the reasons stated above. Support for these amendments can be found in the preamble of Claim 1 and in Fig. 4.

No new matter has been added.

This response attends to each point noted by the Examiner. The claims are proper and patentable. Allowance is respectfully requested. However, should the Examiner deem that further clarification of the record is in order, we invite a telephone call to the applicant prior to the issuance of the next office action to expedite further processing of the claims to allowance.

Dated: May 23, 2005

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Richard M. Lehrer", written over a horizontal line.

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